



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,934	12/11/2000	Patrick Neal Fuller	56838-012	2299
7590 09/09/2004				
McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096		EXAMINER IRSHADULLAH, M		
		ART UNIT PAPER NUMBER		
		3623		

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/732,934

**Applicant(s)**

FULLER, PATRICK NEAL

**Examiner**

M. Irshadullah

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 15 is objected to because of the following informalities:  
  
Of the two claims numbered 15, first one has been renumbered as claim 14.  
  
Appropriate correction is appreciably required.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claims 1-12 and 15-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 and 15 merely recite abstract ideas. Recited steps of receiving information, accessing a database, sending a message do not apply, involve, use or advance the technological art, since all of the recited steps can be performed in the mind of a user or by use of paper and pencil and using information contained in a filing cabinet. The steps only constitute an abstract idea of facilitating advocacy.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the instant case, the invention produces a useful, concrete and tangible result: "sending a message to a political official".

Thus, the claimed invention is an abstract idea, produces useful, concrete and tangible result, the claimed invention as a whole is not within the technological art as explained above. Claims 1 and 15, therefore, deemed to be directed to non-statutory subject matter.

Claims 1 and 15 are, therefore, rejected under 35 U.S.C. 101, and same rationale holds for claims 2-12 and 16-23.

In order to overcome the rejection, it is suggested to recite computation device or computer within claim step or steps and claim language be amended in the light of above stated reasons.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3623

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the step of composing the message". There is insufficient antecedent basis for this limitation in the claim.

Claim 5 and dependent claims 6-9 are, therefore, rejected under 35 U.S.C. 112, second paragraph.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless: –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaw et al (US Patent 6,311,211 B1).

Shaw et al disclose:

Claim 1. A method for facilitating political advocacy on-line, comprising the step:

a) receiving personal information that identifies an advocate (Col. 8, lines 27-46, wherein cited collecting information, such as name, address etc., from a user establishing account indicating "receiving information which recognizing or identifying a user" and user being a generic term encompassing claimed "advocate". Moreover, advocate is a person or group thereof who send information about an issue to the public, col. 3, lines 27-32". Furthermore, reference server 104 functioning as an intermediary, col. 6, lines 42-47, implying that said advocate or advocacy person or group thereof would also establish account with the reference system and the system collecting or receiving information, such as name, address etc., which information recognizing or identifying said advocate or advocacy person or group thereof);

b) accessing a voter database to retrieve voter information about the advocate on the personal information (Col. 23, lines 5-16, wherein cited selecting users in accordance with particular congressional district based on said district's zip codes from user database or voter registration database indicating system "selecting from or accessing user database, Fig. 14 {2330} or cited voter registration database corresponding to zip codes or personal information or any of the above discussed user name, address etc., and a user would employ reference's "retrieving function, col. 7, lines 23-30" for extracting or retrieving above discussed voter information); and

c) sending a message to a political official based on voter information (Col. 23, lines 27-30, wherein cited advocacy platform 2300 sending messages to representative or political official 2400 indicating reference's teach the claimed limitation, and sent information relating to above discussed user or voter information).

Claim 2. The method according to claim 1, wherein the personal information includes name and address of the advocate (Col. 8, lines 42-46, wherein cited user representing "advocate" and cited name, address relating to said advocate).

Claim 3. The method according to claim 2, wherein the personal information includes a date of birth of the advocate (Col. 8, lines 42-46, wherein cited other information encompassing "date of birth". The date of birth is essential information in voter registration, since only a person or voter of certain age is eligible to vote).

Claim 4. The method according to claim 1, wherein the voter information includes whether or not the advocate is registered to vote (Col. 8, lines 42-46, wherein cited other information including claimed one).

Claim 5. The method according to claim 4, further comprising the step of composing message to indicate whether or not the advocate is registered to vote (Col. 23, lines 27-30, wherein cited sending message encompassing writing or composing the message and a user would use said message writing or composing function for including claimed limitation).

Claim 6. The method according to claim 4, wherein the voter information includes legislative district the voter is qualified to vote in (A user would use above discussed message writing or composing function for including claimed limitation).

Claim 7. The method according to claim 6, further comprising the step of composing message to indicate the legislative district the voter is qualified to vote in (A user would use above discussed message writing or composing function for including claimed limitation).

Claim 8. The method according to claim 4, wherein the voter information further includes a voting history of the advocate (A user would use above discussed message writing or composing function for including claimed limitation. Moreover, reference's summary report of responses to advocacy message, col. 4, lines 10-13, indicating reference's teaching collecting information for "summary or history", which functionality a user would use for collecting said history relating to the advocate).

Claim 9. The method according to claim 8, further comprising the step of composing the message to indicate the voting history of the advocate (A user would use above discussed message writing or composing function for including claimed limitation).

Claim 10. The method according to claim 1, further comprising the step of identifying the political official based on the voter information (Col. 23, lines 5-16, wherein cited selecting representative by zip codes in a congressional district or representative on a particular committee indicating "recognizing or identifying representative or political official depending on zip codes or voter information).



Claim 11. The method according to claim 1, further comprising the step of causing an action alert to be displayed to the advocate (Col. 17, lines 30-35, wherein a user would use cited "alert" function for claimed purpose).

Claim 12. The method according to claim 1, further comprising digitally signing the message (Col. 22, lines 23-32, wherein cited signing automatically indicating system's creating computerized or digital sign).

Claim 13. A web site for facilitating political advocacy (Col. 6, lines 5-8 recited with lines 45-47 and col. 2, lines 30-35, wherein cited wide area network and internet indicating reference system's use of web functionality and user would employ the same for web siting, col. 2, lines 30-35, purpose), comprising:

a) means for receiving personal information that identifies an advocate (See discussion of Applicant's claim 1a) above);

b) means for accessing a voter database to retrieve voter information about the advocate based on the personal information (See discussion of Applicant's claim 1b) above); and

c) means for sending a message to a political official based on the voter information (See discussion of Applicant's claim 1c) above).

Claim 14. A computer-readable medium bearing instructions for facilitating political advocacy on-line, said instructions being arranged to cause one or more

processors upon execution (Fig. 1 {Server 104, database 106}, wherein cited server has to have storage means, such as HD, CD, Diskette etc., and said means are employed to store programs, codes, applications or instructions. Similar holds for database 106) for thereby to perform the steps of:

- a) receiving personal information that identifies an advocate (See discussion of Applicant's claim 1a) above);
- b) accessing a voter database to retrieve voter information about the advocate based on the personal information (See discussion of Applicant's claim 1b) above); and
- c) sending a message to a political official based on the voter information (See discussion of Applicant's claim 1c) above).

Claim 15. A method for on-line targeted political advocacy (Col. 21, lines 5-26, wherein cited invention providing advertisements or advocacy messages {col. 20, lines 34-36} on-line indicating reference's teaching "on-line" functionality and representative including targeted entity pointing to reference's teaching of its use for "targeted" purpose), wherein, comprising the steps of:

- a) receiving a selection targeting one or more political officials (See discussion of Applicant's claim 1a) above);
- b) accessing an advocate database including voter information to identify one or more advocates that are registered to vote in a corresponding voting district of the one or more political officials (See discussion of Applicant's claim 1b) above); and

c) sending an action alert to the one or more identified advocates (See discussion of Applicant's claim 1c) above).

Claim 16. The method according to claim 15, further comprising the step of presenting a form allowing a grassroots coordinator to select the one or more political official (Col. 14, line 64 through col. 15, line 1, wherein cited template representing "form" which a user would use for claimed purpose using reference's "selecting function, col. 14, lines 58-60", and user being generic term encompassing "grassroots coordinator").

Claim 17. The method according to claim 16, wherein the form permits the grassroots coordinator to select officials at a local, state, or federal level (Col. 14, line 1 through col. 15, line 1 read with col. 21, lines 16-24, wherein cited template representing "form" which a user would use for claimed purpose using reference's "selecting function, col. 14, lines 58-60", cited "US senate, house and locally elected officials" representing the claimed ones, and user being generic term encompassing "grassroots coordinator").

Claim 18. The method according to claim 16, wherein the form permits the grassroots coordinator to select officials by type of office, including president, senator, representative, governor, state senator, or state delegate (Col. 14, line 1 through col. 15, line 1 read with col. 21, lines 16-24, wherein cited template representing "form" which a user would use for claimed purpose using reference's "selecting function, col.

Art Unit: 3623

14, lines 58-60", cited "US senate, house and locally elected officials etc." representing the claimed ones, and user being generic term encompassing "grassroots coordinator").

Claim 19. The method according to claim 16, wherein the form permits the grassroots coordinator to select officials belonging to a specified legislative committee or caucus (Col. 14, line 1 through col. 15, line 1 read with col. 21, lines 16-24, wherein cited template representing "form" which a user would use for claimed purpose using reference's "selecting function, col. 14, lines 58-60", cited "US senate, house and locally elected officials" representing the claimed one, and user being generic term encompassing "grassroots coordinator").

Claim 20. The method according to claim 15, further comprising the step of prompting a grassroots coordinator to compose the action alert (Col. 18, lines 41-48, wherein a user or grassroots coordinator would use cited "composing" function for claimed purpose and see discussion about "alert" in Applicant's claim 11 above).

Claim 21. The method according to claim 15, further comprising the step of embedding a hyperlink in the action alert said hyperlink indicating a web site whereat an advocate can send a message to an elected official representing the advocate (Col. 18, lines 45-48, wherein cited buttons 1206 etc., representing "icons or embedded hyperlinks" and a user or grassroots coordinator would use the same for claimed purpose. Moreover, embedded hyperlinks are practiced in computer art so long before

Art Unit: 3623

Applicant's invention that a user would consider their use as inherent or at least be motivated to use them for claimed purpose).

Claim 22. The method according to claim 15, wherein the step of sending the action alert includes sending the action alert by electronic mail (Col. 19, lines 9-10, wherein a user would use cited sending function and e-mail for sending above discussed alert message).

Claim 23. The method according to claim 15, wherein the step of sending the action alert includes sending the action alert by facsimile (Col. 23, lines 30-31, wherein a user would use cited facsimile for claimed purpose).

Claim 24. A web site for on-line targeted political advocacy (See discussion about web site in claim 13 and discussion about "targeted" functionality in claim 15 above), comprising the steps of:

a) means for receiving a selection targeting one or more political officials (See discussion of Applicant's claim 1a) above);

b) means for accessing an advocate database including voter information to identify one or more advocates that are registered to vote in a corresponding voting district of the one or more political officials (See discussion of Applicant's claim 1b) above); and

c) means for sending an action alert to the one or more identified advocates (See discussion of Applicant's claim 1c) above).

Claim 25. A computer-readable medium bearing instructions for on-line targeted political advocacy, said instructions being arranged to cause one or more processors upon execution (See discussion Applicant's claims 14 and 15) thereby to perform the steps of:

a) receiving a selection targeting one or more political officials (See discussion of Applicant's claim 1a) above);

b) accessing an advocate database including voter information to identify one or more advocates that are registered to vote in a corresponding voting district of the one or more political officials (See discussion of Applicant's claim 1b) above); and

c) sending an action alert to the one or more identified advocates (See discussion of Applicant's claim 1c) above).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Khuzadi et al., US Patent 2001/0049616 A1. Group Funding For Network Computer Systems.

B) Shaw et al., US Patent 6,199,106 B1. Electronic Mail System With Advertising.

C) Marsh et al., US Patent 5,848,397. Method And Apparatus For Scheduling The Presentation Of Messages To Computer Users.


D) Fan, US Patent 5,371,673. Information Processing Analysis System For Sorting And Scoring Text.

E) Marino et al., US Patent 4,850,007. Telephone Toll Service With Advertising.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is 703-308-6683. The examiner can normally be reached on 10:00 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
M. Irshadullah  
August 27, 2004

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600